

REMARKS

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Gilhousen, et al. (USPN 6,421,540). Claims 5-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilhousen, et al. (USPN 6,421,540) in view of Rahnema (USPN 5,465,253). Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gilhousen, et al. (USPN 6,421,540) in view of Jang, et al. (US 2003/0211847).

Applicants thank the Examiner for taking the time to discuss this case in a telephone interview on 20 February 2006. During the telephone conference, the Examiner noted that Applicants claimed invention (as amended in Reply dated 5 July 2005) overcomes Gilhousen because Applicants' claims require that the subscriber perform the steps of Claim 1, e.g., transmitting information on the assigned channel, and Gilhousen teaches or suggests technology related to a paging system where none of the terminals in the paging system have the capability to transmit information. Thus, Applicants and the Examiner agreed that Gilhousen is an appropriate basis for rejecting Applicants' claims. As such, Gilhousen either alone or in combination with the other art references are an inappropriate basis for rejecting Applicants' claims. Thus, Applicants' note that Claims 1-10 are in allowable form and Applicants' look forward to an early notice of allowance of these claims.

Claims 11-13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corrigan, et al. (USPN 5,818,825) in view of Rahnema (USPN 5,465,253). Claims 11 and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Vannucci (USPN 5,459,727).

Applicants note that the Examiner probably meant to reject Claims 11 and 14-15 under 35 U.S.C. 103(a) as being unpatentable over Vannucci in view of Rahnema. The remarks on page 5 indicate that Vannucci lacks the teaching to "reverse channel signaling being transmitted in a shared field associated with another call;" therefore, it follows that Applicants' claims can

not be rejected under 35 U.S.C. 102(b) as being anticipated by Vannucci. As such, Applicants' remarks below comment on the combination of Vannucci with Rahnema.

Applicants respectfully traverse the rejections and request reconsideration. It is incumbent upon the Examiner to prove a *prima facie* case of obviousness (MPEP 2143). To establish a *prima facie* case three basic criteria must be met. First, the prior art reference must teach or suggest all the claim limitations. Second, there must be a reasonable expectation of success. Finally, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. The Examiner has used impermissible hindsight to find that Applicants' claims are disclosed by the combinations of Corrigan with Rahnema and Vannucci with Rahnema. As such, rejections under 35 U.S.C. § 103 are improper and should be withdrawn. Applicants' note that Claims 11-12, 14, and 16 are in allowable form and Applicants' look forward to an early notice of allowance of these claims.

In the event that the Examiner deems the present application non-allowable, it is requested that the Examiner telephone the Applicant's attorney or agent at the number indicated below so that the prosecution of the present case may be advanced by the clarification of any continuing rejection.

Please charge any fees that may be due to Deposit Account 502117, Motorola, Inc.

Respectfully submitted,

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